



Docket No.: P1139.0011/P011
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Chad Roberts et al.

Application No.: 10/092,259

Confirmation No.: 9265

Filed: March 7, 2002

Art Unit: 2175

For: APPARATUS AND METHOD FOR
CONFIGURING HANDHELD ELECTRONIC
DEVICES

Examiner: B. M. Ortiz

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 *et seq.* from the Final Rejection rejecting claims 1-19 in the above-identified application and mailed on May 31, 2005. The fee for submitting this Brief (\$500.00, 37 C.F.R. § 1.17(c)) is attached hereto. A petition for extension of time (one-month) is being filed concurrently herewith. Any deficiency in the fee associated with this Brief should be charged to our Deposit Account No. 04-1073. The Notice of Appeal was filed on August 31, 2005.

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This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

I.	Real Party In Interest
II	Related Appeals and Interferences
III.	Status of Claims
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V.	Summary of Claimed Subject Matter
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VIII.	Conclusion
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Appendix B	Evidence Appendix (none)
Appendix C	Related Proceedings (none)

I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

PDA Verticals Corp.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 19 claims pending in the application.

B. Current Status of Claims

1. Claims canceled: none.
2. Claims withdrawn from consideration but not canceled: none.
3. Claims pending: 1-19.
4. Claims allowed: none.
5. Claims rejected: 1-19.

C. Claims On Appeal

The claims on appeal are claims 1-19.

IV. STATUS OF AMENDMENTS

Applicant filed an Request for Reconsideration on August 1, 2005. The Examiner responded to the Request for Reconsideration in an Advisory Action mailed September 19, 2005.

The claims enclosed herein in Appendix A incorporate the amendments indicated in the paper filed by Applicant on January 21, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The invention is directed to a system and method for configuring handheld devices. The system includes a website engine, a database, a build-to-order configuration engine, and a loader. The system utilizes the aforementioned components to pre-load and configure selected software for the user. Among other things, the build-to-order engine communicates with developers, coordinates software licenses, arranges software downloads and prevents conflicts. The loader provides actual downloads for loading the handheld device based on user input received through the website engine which conveys the user input to the database and build-to-order configuration engines.

VI. GROUNDS OF OBJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-18 are properly rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. publication 2002/0090934 dated by Mitchelmore et. al. (hereinafter “Mitchelmore”).

B. Whether claim 19 is properly rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. publication 2002/0090934 dated by Mitchelmore et. al. (hereinafter “Mitchelmore”).

VII. ARGUMENT**A. Claims 1-18 are not Anticipated by the Disclosure of Mitchelmore**

Independent claim 1 recites a system for configuring handheld devices. The system comprises, *inter alia*, a “build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts.”

The Final Rejection alleges that claim 1 is anticipated by the disclosure of Mitchelmore (Final Rejection dated May 31, 2005, pg. 3-4). More specifically, the Final Rejection relies on paragraphs 8, 18-19, 65, 100, 178, 181 and 183 of Mitchelmore for teaching the above limitation. However, these paragraphs fail to disclose or even suggest a “build-to-order configuration engine” for “communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts” as set forth in claim 1.

The present invention as claimed focuses on the software download and configuration process from the point-of-view of the end-user of the PDA device by pre-loading and configuring selected software for the user. Corresponding to the language of claim 1, the “build-to-order configuration engine” shields the user from having to “communicat[e] with developers, coordinat[e] software licensing, arrang[e] software downloads and prevent[] conflicts” by themselves. Specification definition and support for these features are as follows:

With regard to shielding the user from developers, the specification discloses that the license keys are delivered to the user with the software so there is no need for the user to

communicate with developers. Specification, paragraph [00027]. With regard to shielding the user from coordinating software licensing, the specification discloses that the website will “collect any information required … by the software to complete the registration/activation” and “orchestrates the various registration methods to gather the registration codes.” Specification, paragraphs [00026] and [00022]. With regard to shielding the user from arranging software downloads and preventing conflicts, the specification discloses that the claimed process does “a complete load of the software on to the device,” and as the user “adds items to her built-to-order system, the catalog automatically checks each user-selected item to make sure it can be loaded on the selected device, that there is enough memory left to add the application, and that there are no other conflicts.” Specification, paragraph [00019] and [00018]. The specification also discloses that there is a “dependency checker” which is used to properly configure the software downloads and hardware installations and prevent conflicts. Specification, paragraphs [00020] – [00021]. All of these features of the present invention, disclosed in the specification, highlight the fact that the “build-to-order configuration engine” of claim 1 relates to the abstraction of the software download and PDA configuration process for the end user and does not relate to the providing of content.

By contrast, Mitchelmore refers mainly to user interactions with the content developer. Mitchelmore requires the user to install specific software to interact with the system. The cited paragraphs selectively refer to how the system makes it easier for the content developer to provide his content to the system and to manage the content. Each of the cited paragraphs is discussed more specifically below:

Paragraph 8 of Mitchelmore relates to offering licensed development platforms which are previously existing programming tools for building PDA tools for wireless devices. These development platforms are for use by a content developer to deliver and provide content to a device. They are not for use by an end-user of a PDA for configuring his handheld device. Additionally, the “licensed development platform” of paragraph 8 does not disclose the “coordinating software licensing” portion of claim 1. Instead, a “licensed development platform” is generally known in the art as a set of tools provided by a computer system owner in order to allow programmers to create programs which will be compatible with their system, thereby encouraging more people to buy and use their system.

On the other hand, “software licensing” as provided in claim 1 refers to the variety of license keys required for using newly purchased software and generally, the installation of the software is conditional to the user accepting the agreement and thereby agreeing to abide by its terms. The software purchaser must keep track of all of his software licenses in order to be able to continue to use the software; this is not required for the use of a licensed development platform. The present invention coordinates the software licenses needed by the end user to run the software. Specification, paragraph [00026].

Paragraph 18 of Mitchelmore relates to providing more effective and efficient content delivery. Paragraph 19 of Mitchelmore relates to an embodiment which allows for content developers to “generate, monitor and manage revenue.” These paragraphs refer to the originator of content’s ability to publish content, manage revenue and efficiently get paid. As previously mentioned, these paragraphs refer to how the Mitchelmore system makes it easier for the content developer to provide his content to the system and to manage the content; they do not refer to or disclose a “build-to-order configuration engine” as described in the Specification which allows the end user of the PDA to configure their PDA at an abstracted level.

Paragraph 65 of Mitchelmore relates to a graphical user interface (GUI) which provides for data entry. Paragraph 100 of Mitchelmore describes a subscription manager that may be compatible with other technologies and may be implemented using these technologies. This GUI and subscription manager allow the content originator to provide and publish content and allow him to view and add channel subscriptions and make them available for the end users. These paragraphs refer only to the ability of the content developer to publish content and make it available for download by a user. In the present invention, the user interface of the website allows the user to choose a specific handheld device, select software, and perform other personalized tasks. *See Specification, paragraph [00029].* Additionally, although paragraph 100 refers to “configuration information,” this relates to configuring the subscription manager for downloading static content and not to configuring the software and accessories for the PDA itself. These cited paragraphs do not disclose the user selecting applications and configuring his PDA device through a “build-to-order configuration engine.”

Paragraph 178 of Mitchelmore relates to a content developer administering the details of an application that he is making available. This administration may include posting a subset of details, relating to an application, on an associated server. This paragraph does not disclose the “arranging software downloads” element of claim 1. This element of claim 1 refers to the system of claim 1 arranging for downloading the software which was selected by the end user during the configuration process. The software is selected by the user through the user interface and then the process does a complete load of the software onto the device. Specification, paragraphs [00019] and [00029]. Paragraph 178 discloses a way for the content developer to provide information about an application available for download to the users who may download the application at some point in time. Paragraph 178 does not disclose how the end user’s many software downloads will be arranged and coordinated as is required by the “arranging software downloads” language of claim 1.

Paragraph 181 of Mitchelmore relates to requesting application files directly from a developer’s server. This paragraph refers to a specific method by which Mitchelmore’s subscription manager may request applications. The present application does not claim a specific method of requesting applications; instead it claims the arranging of software downloads by the build-to-order configuration engine. This is not disclosed by paragraph 181.

Paragraph 183 of Mitchelmore relates to installation packages and indicates that the installation packages are required for downloading content and that they may be implemented using various technologies or they may be compatible with various technologies. However, any specific installation package from Mitchelmore is only compatible with a specific device, *i.e.* the installation package is “device-specific.” Mitchelmore, paragraph [0183]. The system of claim 1 is compatible with any device, *i.e.*, it is not “device-specific” and it does more than allow software to be downloaded; it also prevents conflicts among software chosen by the user. Specification, paragraph [00018].

In sum, all of these paragraphs fail to provide disclosure or suggestion of a “build-to-order configuration engine” for “communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts.”

Further, the Final Rejection quotes paragraphs 18 and 183 of Mitchelmore as disclosing a “build-to-order configuration engine” for “communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts.” However, as previously noted, neither of these paragraphs provide any disclosure for this portion of the claim.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Mitchelmore fails to teach all of the limitations of independent claim 1 and does not thereby anticipate claim 1. Additionally, “the identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). This is not achieved by the disclosure in Mitchelmore. Mitchelmore describes a system for pushing content being provided by a content developer to a PDA subscriber, whereas the present application describes a system for full configuration of the software and accessories of a PDA either before or after purchase where the system will additionally assure that all software and accessories are compatible with each other and with the device.

Dependent claims 2-18 depend from independent claim 1 and are hence patentably distinguishable over Mitchelmore for at least the same reasons attributable to claim 1. Accordingly the rejection set forth in the Final Rejection as applied against claims 1-18 is unsustainable and should be overturned.

B. Claim 19 is not Anticipated by the Disclosure of Mitchelmore

Independent claim 19 recites, *inter alia*, “querying a build-to-order configuration engine to ensure sufficient memory is available to accommodate the software,” querying “that the O/S can accommodate the software” and “querying the handheld device to ensure sufficient memory is available and reporting an error back to the user if necessary.”

The Final Rejection alleges that claim 19 is anticipated by the disclosure of Mitchelmore (Final Rejection dated May 31, 2005, pg. 7). The specific rejections are discussed in detail below.

The Final Rejection relies on paragraphs 18-19, 100, 178, 181, and 183 of Mitchelmore to disclose “querying a build-to-order configuration engine to ensure sufficient memory is available to accommodate the software.” Paragraph 18 relates to providing more effective and efficient content delivery. Paragraph 19 relates to an embodiment which allows for content developers to “generate, monitor and manage revenue.” These paragraphs refer to the originator of content’s ability to publish content, manage revenue and efficiently get paid. Paragraph 100 relates to the subscription manager which enables a user to keep track of current subscriptions. Paragraph 178 relates to a content developer administering the details of an application that he is making available. Paragraph 181 relates to a specific method by which Mitchelmore’s subscription manager may request application files directly from a developer’s server. Paragraph 183 relates to installation packages and indicates that the installation packages are required for downloading content and that they may be implemented using various technologies or they may be compatible with various technologies. A more in-depth discussion of why these paragraphs do not disclose a “build-to-order configuration engine” is available in the previous section. Additionally, none of these paragraphs discuss memory availability or provide disclosure for “querying a build-to-order configuration engine to ensure sufficient memory is available to accommodate the software.”

Further, the Final Rejection relies on paragraph 5 of Mitchelmore to anticipate querying the “build-to-order configuration engine” to determine “that the O/S can accommodate the software.” Paragraph 5 describes the ubiquity of instant mobile information. It is not at all related to accommodation of software by an operating system. Therefore, this paragraph fails to disclose querying the “build-to-order configuration engine” to determine “that the O/S can accommodate the software.”

The Final Rejection also relies on paragraphs 100 and 182 of Mitchelmore to anticipate the limitation of “querying the handheld device to ensure sufficient memory is available and reporting an error back to the user if necessary”.

Paragraph 100 of Mitchelmore describes the subscription manager which enables a user to keep track of current subscriptions and that it may be compatible with other technologies and may be implemented using these technologies. However, this paragraph does not disclose anything regarding the amount of memory available on the handheld device or querying whether there is enough memory to accommodate a software download.

Paragraph 182 of Mitchelmore relates to notifications (e.g. promotional messages) that appear on the handheld device and that these notifications may be transferred to or from the handheld device and the desktop computer. Nowhere in this paragraph does Mitchelmore refer to a query of whether there is sufficient memory to accommodate a software download.

As previously noted, each and every element set forth in the claim must be either expressly or inherently described in Mitchelmore. Mitchelmore, however, fails to teach all of the limitations of independent claim 19 and does not thereby anticipate that claim. Additionally, “the identical invention must be shown in as complete detail as is contained in the ... claim.”

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). This is not achieved by the disclosure in Mitchelmore. Neither in the cited paragraphs, nor anywhere in the entire Mitchelmore publication, does Mitchelmore disclose querying how much memory is available on the handheld device to ensure enough space for the desired download. Furthermore, Mitchelmore does not discuss reporting to the user the need for additional memory, such as a memory card, if sufficient memory is not available, as is recited in claim 19. Accordingly the rejection set forth in the Final Rejection as applied against claim 19 is unsustainable and should be overturned.

VIII. CONCLUSION

For each of the foregoing reasons, Appellant respectfully submits that the claimed invention is not anticipated by the cited prior art, and reversal of each of the final grounds of rejection is respectfully solicited.

Dated: November 30, 2005

Respectfully submitted,


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APPENDIX A - CLAIMS**Claims Involved in the Appeal of Application Serial No. 10/092,259**

1. (Previously Presented) A system for configuring handheld devices, comprising:
 - a website engine, for receiving user input;
 - a build-to-order configuration engine for communicating with developers, coordinating software licensing, arranging software downloads and preventing conflicts;
 - a database engine, for managing executable code and data responsive to said configuration engine, and
 - a loading station for performing the actual downloads;wherein said loading station loads said handheld device based on user input received through said website engine and conveyed to said database and build-to-order configuration engines.
2. (Previously Presented) The system of claim 1, wherein said configuration engine communicates automatically with said developers using a registration module.
3. (Previously Presented) The system of claim 2, wherein said registration module communicates with said developers using either pooled, generated, or dynamically requested communications.
4. (Previously Presented) The system of claim 1, wherein said registration module supports the random-key method of software registration.

5. (Previously Presented) The system of claim 1, wherein said registration module supports the device-ID method of software registration.

6. (Previously Presented) The system of claim 1, wherein said loading station further comprises a transfer component, which transfers data back and forth over a physical medium through a port, and an operating system driver layer, which handles the actual moving of the bits through said port over said physical medium.

7. (Previously Presented) The system of claim 6, wherein said transfer component is abstracted such that it sees differing connection types as the same, because said operating system driver layer is responsible for the actual moving of the bits.

8. (Previously Presented) The system of claim 7, wherein software drivers of said connection types can be added to or removed from said loading station.

9. (Previously Presented) The system of claim 7, wherein software drivers of said connection types are extended from sample software modules obtained from product developers.

10. (Previously Presented) The system of claim 1, wherein said build-to-order configuration engine contains links of which handheld applications cannot coexist with each other or are incompatible with specific handheld hardware

11. (Previously Presented) The system of claim 10, wherein said build-to-order configuration engine receives data from the handheld device itself through the communication port of said loading station.

12. (Previously Presented) The system of claim 10, wherein said build-to-order database further comprises a database catalog which contains information about a plurality of handheld software products, including what Operating System (O/S) version that product may require, the memory consumption of that product, what other software applications the product may be dependant upon, or any other products/applications that it conflicts with.

13. (Previously Presented) The system of claim 10, wherein said build-to-order database further comprises a database catalog which contains information about a plurality of handheld software products, including what Operating System (O/S) version that product may require, the memory consumption of that product, what other software applications the product may be dependant upon, or any other products/applications that it conflicts with.

14. (Previously Presented) The system of claim 1, wherein said database engine comprises a database catalog which contains handheld software pricing and supplier information, lead time, descriptions, sales volume levels, product shots (images).

15. (Previously Presented) The system of claim 14, wherein said database engine further comprises a dependency checker portion for comparing parameters related to each piece of software.

16. (Previously Presented) The system of claim 1, wherein said build-to-order configuration engine further comprises a plurality of registration code mechanisms each supported by a specialized registration module.

17. (Previously Presented) The system of claim 16, wherein said build-to-order configuration engine further comprises a plurality of registration code mechanisms which can complete the registration process even when all software is preloaded on the handheld device.

18. (Previously Presented) The system of claim 1, wherein a customer sends an existing handheld device to a location having a build-to-order configuration engine, a database engine, and a loading station, wherein said customer accomplishes all download registrations without using said website engine.

19. (Previously Presented) A method of loading software onto a handheld device, comprising:

querying a build-to-order configuration engine to ensure sufficient memory is available to accommodate said software, that the desired software has no conflicts with any other software desired by said user, and that the handheld device O/S (Operating System) can accommodate said software;

querying said handheld device to ensure sufficient memory is available, and reporting an error back to said user if necessary;

if necessary, prompting a user to order additional memory such as on a memory card; and locating said software program on said memory card where possible.

APPENDIX B - EVIDENCE

NONE

APPENDIX C – RELATED PROCEEDINGS

NONE